

## **REMARKS**

Claims 1-3 are pending in this Application. Claims 1-3 were rejected.

Applicant has amended claims 1-3.

### **35 U.S.C. §103(a)**

#### **Claims 1-3 by Ingargiola et al.**

The Examiner rejected claims 1-3 under 35 U.S.C. §103(a) as being anticipated by Ingargiola et al. (5,748,087).

In making the rejection, the Examiner stated:

In considering claims 1-3, the claimed subject matter that is met by Ingargiola et al. (Ingargiola) includes:

- 1) the electronically activated controller is met by the circuit board (40);
  - 2) the activation means and the activation means being pressure based is met by the switch(54A);
  - 3) the alarm means is met by the visual alarm(46).
- Ingargiola does not show:
- 1) the device being affixed to the top of a shoe;
  - 2) the accelerometer based activation means.

With regards to the device being on top of the shoe, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the warning device in a place deemed to promote safety. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the device on top of the shoe, since downward motion to activate the switch would have been facilitated easier than a sideward motion.

With regard to the accelerometer based activation means, the examiner takes official notice that in the shoe signal art, use of accelerometers for activating shoe alarm is well known, and therefore, it would have been obvious to one of ordinary skill to substitute an accelerometer into the switch, since this would have provided a reliable and accurate means for activating the alarm.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must demonstrate that there is a suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine the reference teachings. Furthermore, the prior art references must teach or suggest all of the claimed features. It is well settled law that the prior art itself must provide the motivation for a proposed alteration of a reference. Ex parte Chicago Rawhide Manufacturing Co., 220 U.S.P.Q. 351, (B.O.P.A. 1984). Moreover, the suggestion must be plain and clear or the rejection is untenable. Fromson v. Offset Plate, Inc., 225 U.S.P.Q. 26, 32 (Fed. Cir. 1985); Kimberly-Clark Corp. v. Johnson & Johnson, 223 U.S.P.Q. 603, 610 (Fed. Cir. 1984). The Examiner is not free to pick bits and pieces from the prior art and, with the hindsight benefit of applicants' disclosure, attempt to reconstruct the invention. Orthopedic Equipment, Inc. v. U.S., 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

Although some similarities exist between the present invention and the invention described in the Ingargiola et al. patent, the two devices are patentably distinct, and there is no motivation or suggestion in the Ingargiola reference that it be modified to create the present invention. In fact, some aspects of the Ingargiola reference teach away from the distinguishing features of the present invention. The structural variations between the two devices, the use of an accelerometer, and how and where the device is attached to a shoe are the result of the dissimilar functions for which each invention was primarily designed to perform.

The Ingargiola et al. patent describes a device consisting of a handheld transceiver held by a parent/guardian and a transceiver located within a tracked individual's footwear. The stated object of this invention is "to provide a system for monitoring the location of an individual within a predetermined boundary range." It is clear from the words and context of the Ingargiola patent that the device is primarily intended to be used as a monitoring/tracking device. It is also true that the Ingargiola device comprises a "pushbutton type switch 54A" that can be activated by the wearer of the shoe to "alert the parent that the child is in trouble." However, the fact that the panic button function is only sparingly mentioned in the Ingargiola reference compared to its voluminous description of the tracking feature is strong evidence that the Ingargiola device is primarily a tracking device. Furthermore, the panic button feature of the Ingargiola device only notifies the parent that the child is lost or in danger, by causing "the handheld unit [to] produce a higher frequency alarm." A 'panic button' is defined as, "a button to push in order to summon help in case of an emergency."

Wordnet 2.0, Princeton University (2003). By contrast, the present invention would notify everyone within the vicinity of the child, or any other user of the shoe alarm, that he or she was being attacked because the alarm is actually on the child's shoe. Ingargiola's alarm would only notify the parent or others near the handheld unit, who could hear the higher frequency alarm emitted by the handheld unit.

Applicant's invention can also be described as a monitoring device, though it is more accurately described as a panic button capable of being

activated by the wearer. The monitoring capacity of Applicant's shoe alarm rests in the sound emitted from the activated alarm, which is not unlike a child's scream or cry for help. The parent would come to the child's assistance upon hearing the alarm and using the alarm's sound to locate the child.

Unlike the Ingargiola device, the monitoring and activation functions of the present invention are performed solely by the wearer of the shoe alarm.

Therefore the monitoring capabilities of the present invention are greatly limited compared to the monitoring capacity of the Ingargiola invention, which allows the parent/guardian to the shoe's wearer using the handheld transceiver.

A key distinguishing feature between the Ingargiola device and the present invention is that the present invention is a separate device apart from the shoe itself. It is designed to be "affixed to the top of a shoe" whereas the Ingargiola invention is "integrally formed in each of a pair of footwear apparel." There are advantages and disadvantages to integrating the shoe alarm into the shoe as in the Ingargiola reference, just as there are advantages and disadvantages to having the shoe alarm be a separate device attached to the shoe. One advantage of having the device formed into the sole of the shoe is that it is unlikely to be lost, so long as the shoe itself is not lost. This factor could be of great significance considering the fact that the primary function of Ingargiola's device is "monitoring children" who are more prone to lose things. Furthermore, by integrating the alarm into a child's shoes, it makes it more difficult for the child to tamper with the device. The present invention is only

affixed to the shoe so it could be lost more easily, depending on how it was affixed.

The obvious disadvantage of having the shoe alarm integrated into the shoe is that it can only be used with one pair of shoes. In contrast, the present invention is "preferably removable and may be attached by Velcro or other means." The Ingargiola reference teaches away from this removability feature for two reasons. The first is that the Ingargiola device is inherently going to be a bulkier device than the present invention due to its increased number of features, including a transmitter, a receiver, and visual alarm. This larger device would be bulky and unsightly if affixed to the top of a shoe such as the present invention. The second reason that Ingargiola teaches away from removability was mentioned above. That reason being that an integrated system, such as that claimed by Ingargiola, would be more difficult to either lose or become subject to tampering. If well integrated and concealed, a young child or impaired adult could even be unaware of the device's existence, which would make it even less prone to tampering or being removed by the shoe-wearing individual to avoid being tracked. It would also make it less likely that the attacker would know of the tracking device's existence making it less likely that he or she would remove the shoes to avoid being tracked.

By contrast, it is essential that the wearer of the present invention not only know of the device's existence, but is also able to use it in while he or she is being attacked. It is this critical difference that makes the placement of the

device on the shoe and the activation means for the alarm important distinguishing features when compared to the Ingargiola device.

Likewise, the use of an accelerometer as the means of activation for the alarm in the present invention is a critical distinguishing feature of the present invention. The examiner takes "official notice" that the "use of accelerometers for activating shoe alarm(s) is well known" and does not cite any references for the use of accelerometers in shoe alarms.

Section 2144.03(A) of the MPEP states that, "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." The Federal Circuit has held that, "[i]t is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." In re Zurko, 258 F.3d 1379, 1885 (Fed. Cir. 2001). A Google search, performed on December 14, 2005 found no shoe alarms comprising an accelerometer as the activation means. Only running monitors that use accelerometers in conjunction with shoes were found. The accelerometers used in running monitors measure the distance and speed of a runner, but do not activate any shoe alarms. No evidence of accelerometers being used in conjunction with any shoe alarm was found. As the accelerometer is an important part of the present invention, the Applicant traverses the Examiner's claim that such knowledge is common in the field of shoe alarms and

respectfully requests that the Examiner include specific evidence that the combination of accelerometers and shoe alarms is commonly known in the art.

An accelerometer is an important means of activating a shoe alarm because it allows a person equipped with the present invention to activate the alarm by kicking his or her attacker, kicking violently in the air, or kicking a switch on the shoe alarm with his or her other foot. None of these movements require the user of the device to use his or her hands, which may be restrained by the attacker.

In conclusion, the Ingargiola device is primarily a monitoring device with a panic button being an incidental part of the invention. Even if it were an important part of the invention, Ingargiola's panic button only warns the parent that the child is in trouble, by causing "the handheld unit [to] produce a higher frequency alarm," and must be activated by the "push button type switch." The present invention is primarily a panic alarm that allows the wearer of the alarm to notify others in the vicinity that he or she is being attacked. It can be removably attached to almost any shoe, can be activated by an accelerometer, and can be activated by the user without having to use his or her hands, which may be restrained by an attacker. Furthermore, as the two inventions do not have the same primary purpose it cannot have been obvious to create one invention in view of the other.

## **CONCLUSION**

In view of the foregoing amendments and remarks, it is believed that this Application is now in condition for allowance. Early and favorable reconsideration is respectfully solicited.

If the Examiner has any questions regarding the foregoing amendments and remarks, or if prosecution of this Application could be furthered by a telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

Respectfully submitted,

By:   
SCOTT J. FIELDS  
Reg. No. 32,857

Date: 12/21/05

NATIONAL IP RIGHTS CENTER, LLC  
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BLUE BELL, PA 19422  
(610)-680-2301





IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Non-provisional patent application of

Katherine Musil

Group Art Unit: 2632

Application No: 10/776,673

Examiner Name: Daryl C. Pope

For: EMERGENCY ALARM FOR SHOES

Filing Date: February 10, 2004

Mailing Date of  
Office Action: July 1, 2005

**CERTIFICATE OF MAILING**

Commissioner for Patents  
P.O. Box 1450  
Arlington, VA 22313-1450  
Mail Stop Response

Date of Deposit: 12/21/05

I hereby certify that this Response to Office Action and fee are being deposited with the United States Postal Service via First Class Mail on the date indicated above, addressed to Commissioner for Patents, P.O. Box 1450, Arlington, VA 22313-1450, Mail Stop Response.

SCOTT J. FIELDS

Date: 12/21/05

NATIONAL IP RIGHTS CENTER, LLC  
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(610)-680-2301

# Office Action Summary



Application No

10/776,673

Examiner

DARYL C. POPE

Applicant(s)

MUSIL, KATHERINE

Art Unit

2632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### **ART REJECTION:**

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingargiola et al(5,748,087).**

-- In considering claims 1-3, the claimed subject matter that is met by Ingargiola et al(Ingargiola) includes:

- 1) the electronically activated controller is met by the circuit board(40);
- 2) the activation means and the activation means being pressure based is met by the switch(54A);
- 3) the alarm means is met by the visual alarm(46).

**- Ingargiola does not show:**

- 1) the device being affixed to the top of a shoe;
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With regards to the device being on top of the shoe, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the warning device in any place deemed to promote safety. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention to implement the

device on the top of the shoe, since a downward motion to activate the switch would have been facilitated easier than a sideward motion.

With regard to the accelerometer based activation means, the examiner takes Official notice that in the shoe signal art, use of accelerometers for activating shoe alarm is well known, and therefore, it would have been obvious to one of ordinary skill to substitute an accelerometer into the switch, since this would have provided an reliable and accurate means for activating the alarm.

***Conclusion***

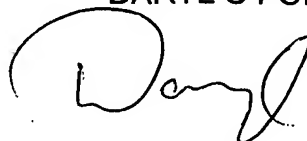
3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARYL C. POPE whose telephone number is (571) 272-2959. The examiner can normally be reached on M-TH 8:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DANIEL WU can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daryl C Pope

DARYL C POPE

A handwritten signature in black ink, appearing to read 'Daryl', with a stylized flourish at the end.

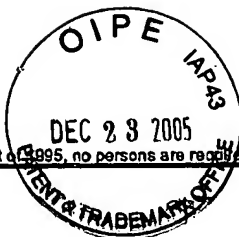
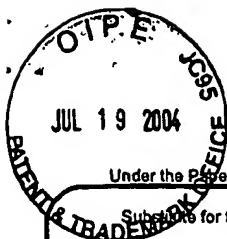
Application/Control Number: 10/776,673  
Art Unit: 2632

Page 4

June 26, 2005

Primary Examiner  
Art Unit 2632

A handwritten signature in black ink, appearing to read "Daryl K. [unclear]", is written over the printed name of the Primary Examiner.



PTO/SB/08A (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO

**INFORMATION DISCLOSURE  
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

**Complete if Known**

Application Number	10/776,673
Filing Date	February 10, 2004
First Named Inventor	Katherine Musil
Art Unit	2632
Examiner Name	NYA
Attorney Docket Number	10719-1

Sheet 1 of 1

U. S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code <sup>2</sup> (if known)			
D.P.	A	US- 5,748,087	05/05/1998	Ingargiola et al.	
	B	US- 5,500,635	03/19/1996	Mott	
	C	US- 6,313,733	11/06/2001	Kyte	
	D	US- 5,188,447	02/23/1993	Chiang et al.	
	E	US- 6,262,660	07/17/2001	Segale et al.	
	F	US- 5,790,949	08/04/1998	Tognazzini	
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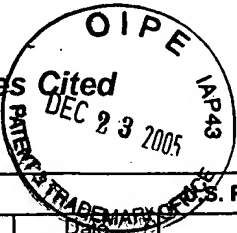
FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T <sup>6</sup>
		Country Code <sup>3</sup> Number <sup>4</sup> Kind Code <sup>5</sup> (if known)				
D.P. ↓	G	EP 121,026	10/10/1984	Alfred Dana III		
	H	EP 335,467	10/04/1989	Intermedium B.V		
	I	GB 2,121,219	12/14/1983	Chyuan-Jong, Wu		
	J	WO 81/02223	08/06/1981	Minnesota Minin		
	K	WO 87/02846	05/07/1987	Hopper, Wm		

Examiner Signature	Date Considered
	6/26/05

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.

<b>Notice of References Cited</b> 	Application/Control No. 10/776,673	Applicant(s)/Patent Under Reexamination MUSIL, KATHERINE	
	Examiner DARYL C. POPE	Art Unit 2632	Page 1 of 1

TRADE MARK OF U.S. PATENT DOCUMENTS					
* Date		Document Number Country Code-Number-Kind Code	MM-YYYY	Name	Classification
	A	US-5,748,087	05-1998	Ingargiola et al.	340/573.7
	B	US-6,012,822	01-2000	Robinson, William J.	362/103
	C	US-6,788,200	09-2004	Jamel et al.	340/539.13
	D	US-6,819,258	11-2004	Brown, William W.	340/825.49
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	F	US-			
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	J	US-			
	K	US-			
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	M	US-			

FOREIGN PATENT DOCUMENTS						
*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS		
*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.